

CENTRAL FAX CENTER

JUL 19 2007

REMARKS

Claims 1-8 and 16-17 are pending. Claims 18-23 are proposed to be canceled herein without prejudice or disclaimer, and claims 9-15 were previously canceled. Entry of this Amendment, and reconsideration of this application are respectfully requested.

ART REJECTIONS

Claims 1-8 and 16-23 have been rejected as allegedly anticipated under 35 U.S.C. § 102(e) by U.S. Patent Application Publication No. 2004/0039786 to Horvitz *et al.* ("Horvitz CIP"). This rejection is respectfully traversed.

Claims 18-23 have been canceled, and the rejection of these claim is moot. In addition, various subject matter relied upon in the Horvitz CIP does not qualify as § 102(e) prior art to Applicants' disclosure, and as such the rejection should be withdrawn. In particular, as noted at MPEP § 2136.03(IV), "In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the U.S. patent reference must have a right of priority to the earlier date under 35 U.S.C. 120 or 365(c) and the parent application must support the invention claimed as required by 35 U.S.C. 112, first paragraph." As described below, the parent applications of Horvitz CIP do not disclose at least one element explicitly recited in the claims. Thus, for at least one element, the Horvitz CIP is not entitled to carry back its 35 U.S.C. 102(e) critical date to the priority dates of its parent applications. Accordingly, the rejection is improper and should be withdrawn.

Horvitz CIP is a continuation-in-part of two U.S. patent applications. The first is U.S. Patent Application Publication No. 2004/0143636 ("Horvitz Parent I"). Horvitz Parent I is a § 371 U.S. national stage application based on international application PCT/US01/08710, the PCT application having been filed on March 16, 2001. The second is U.S. Patent Application Publication No. 2004/0128359 ("Horvitz Parent II"). Horvitz Parent II is a § 371 U.S. national stage application based on international application PCT/US01/08711, the PCT application having been filed on March 16, 2001. Additionally, Horvitz Parent I, Horvitz Parent II and the Horvitz CIP all claim the priority of U.S. Provisional Application 60/189,801 filed on March 16, 2000 ("Horvitz Provisional").

The Office relies upon the disclosed combination of the bulk email filter 114 and the urgency filter 120 of Paragraphs [0034], [0035], and/or [0040] in the Horvitz CIP as allegedly corresponding to the "combining each of said outputs to thereby form said filter for selecting documents" recited in independent claim 1 and the "combining a first one of said plurality of

- 4 -

Amendment

WAI-2829011v1

sub-filters with a second one of said plurality of sub-filters to thereby create an ensemble filter" as recited in independent claim 8. Office Action dated 4/19/07 at pp. 4 and 6.

However, neither the bulk email filter alone, nor a combination of the bulk email filter and the urgency filter are disclosed in either Horvitz Parent I, Horvitz Parent II, or the Horvitz Provisional. Thus the combination of features relied upon by the Office in the Horvitz CIP in the present rejection is not entitled to the earlier filing dates of either the Horvitz Provisional, Horvitz Parent I or Horvitz Parent II. Accordingly, for purposes of the Office's rejection, the combination of features from the Horvitz CIP relied upon cannot have a priority date earlier than the filing date of Horvitz CIP (June 30, 2003). Therefore, because independent claims 1 and 8 are entitled to a priority date of November 15, 2002 by virtue of U.S. Provisional Application 60/426,826, claims 1 and 8 are not properly anticipated by the Horvitz CIP.

Horvitz Parent I is directed to priorities generation and management. Specifically, Horvitz Parent I discloses a system that automatically prioritizes electronic messages according to a learned importance to a user. For example, messages are classified as high, medium, or low importance by utilizing a training set of examples or other messages having similar degrees of importance to create user priority profiles. See Horvitz Parent I Abstract.

Horvitz Parent I discloses a technique of classification wherein a classifier maps an input attribute vector to a confidence that the input belongs to a class. Paragraph [0047]. As shown in Figure 3, new messages are labeled, tagged and/or sorted into one or more folders according to the priorities (e.g., high, medium or low) assigned by the classifier. Paragraph [0151]. However, this reference fails to disclose either the bulk email filter alone or a combination of the bulk email filter and the urgency filter and thus does not provide support for features from the Horvitz CIP on which the Office relies.

Horvitz Parent II is directed to notification platform architecture. Specifically, Horvitz Parent II discloses a system and method that enables a variety of information associated with one or more notification sources to be directed to one or more notification sinks via a notification platform architecture. The architecture includes a context analyzer that determines a user's status such as location and attention focus. A notification manager utilizes the user's status information to determine when and how information generated by the notification sources should be forwarded to the notification sinks. See Horvitz Parent II Abstract. Horvitz Parent II relates specifically to notification. This reference also fails to disclose either the bulk email filter alone or a combination of the bulk email filter and the urgency filter and thus does not provide support for features from the Horvitz CIP on which the Office relies.

Further, the Horvitz Provisional has been reviewed, and it is respectfully submitted that it also fails to disclose either a bulk filter alone or a combination of a bulk filter and an urgency filter. The Horvitz Provisional thus does not provide support for features from the Horvitz CIP on which the Office relies.

In addition, Horvitz Parent I, Horvitz Parent II, and Horvitz Provisional fail to disclose "combining each of said outputs to thereby form said filter for selecting documents" recited in independent claim 1 and "combining a first one of said plurality of sub-filters with a second one of said plurality of sub-filters to thereby create an ensemble filter" as recited in independent claim 8. Therefore, because Horvitz Parent I, Horvitz Parent II, and Horvitz Provisional fail to recite all of the claimed features, these references are not anticipatory. Thus neither the Horvitz CIP, nor Horvitz Parent I, nor Horvitz Parent II anticipate claim 1, and the § 102(e) rejection should be withdrawn.

For at least these reasons, withdrawal of the rejections and allowance of independent claims 1 and 8 are respectfully requested. Dependent claims 2-7, 16, and 17 are allowable at least by virtue of dependency. Allowance of these claims are respectfully requested.

For the Examiner's further information, related U.S. Patent Application No. 10/713,745 Evans *et al.* ("Evans"), filed on the same date as the instant application is currently undergoing prosecution, and contains claims that were also rejected as allegedly anticipated by the Horvitz CIP. Applicants filed a Pre-Appeal Brief Request for Review on June 1, 2007 in that application including substantially similar arguments to those presented above. Subsequently, on June 18, 2007, the Review Panel withdrew the rejection in that application and indicated that a new Action would be forthcoming. According to the Office's PAIR system, a new non-final Office Action has been mailed, but the substance of the action is not yet available on the PAIR system.

Claims 18-23 have been rejected as allegedly obvious over Horvitz CIP in view of U.S. Patent No. 6,430,559 to Zhai ("Zhai"). Claims 18-23 have been canceled without prejudice or disclaimer, rendering this rejection moot. Withdrawal of the rejection is requested.

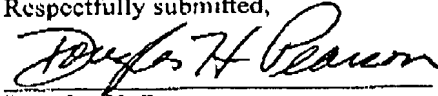
RECEIVED
CENTRAL FAX CENTER
JUL 19 2007

CONCLUSION

In light of the above, Applicants respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (202)879-3939, if a telephone call could help resolve any remaining items.

Date: July 19, 2007

Respectfully submitted,



Douglas H. Pearson

47,851

(Reg. No.)

JONES DAY

51 Louisiana Avenue, N.W.
Washington, DC 200001-2113
(202)879-3939